

Appl. No. : 10/033,371  
Filed : October 19, 2001

### REMARKS

With this amendment, Claims 18-19, 22-24, 27, 32-33, 35-54, and 57-72 are pending in the present application. Claims 18, 22, 32, 37, 43, 49-53 and 57 have been amended, Claims 20-21, 25-26, 34 and 55-56 have been canceled, and Claim 72 has been added. Claims 1-17 and 28-31 were canceled in a previous amendment. Applicant reserves the right to pursue the canceled claims or the scope of the previous, unamended claims at a later date.

#### Claim Rejections – 35 U.S.C. § 102

The Examiner rejected Claims 44, 45 and 52 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,551,303 to Van Tassel et al. (hereinafter “the ’303 patent”). The Examiner asserts that, with respect to Figures 20-22, the ’303 patent discloses a method of implanting a device into the LAA by providing an implantable device 160, 40 into the LAA in the collapsed configuration, and then expanding the device by moving the proximal end closer to the distal end. The Examiner further asserts that Col. 9, lines 22-43 of the ’303 patent disclose that the device can be self-expandable as well as manually actuatable.

Applicant respectfully traverses this rejection and the Examiner’s characterization of the cited reference. Contrary to the Examiner’s assertion, Figures 20-22 of the ’303 patent do not teach or suggest expanding a device by moving the proximal end closer to the distal end. Rather, what is shown in Figures 20-22 is an umbrella structure with struts 160 that are first pushed to the open position, and then, after the struts are in their open position, ratcheting the membrane 40 along the pole 170 to draw the membrane up against the ostium 20. Accordingly, Applicant respectfully submits that the ’303 patent does not teach or suggest the unique combination of features recited by Claim 44, including, inter alia, positioning an implantable device in the left atrial appendage while the device is in its collapsed configuration, and expanding the implantable device in the left atrial appendage, wherein the device is enlarged by providing relative movement between a proximal end and a distal end of the device.

Applicant therefore requests that the rejection of Claim 44 be withdrawn. Applicant further submits that dependent Claims 45 and 52 each recites a unique combination of features not taught or suggested by the cited art, and requests that the rejection of these claims also be withdrawn.

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Claim Rejections – 35 U.S.C. § 103

Claims 18, 20-25, 27, 32-35, 37-43, 46, 47, 53-55 and 58

The Examiner rejected Claims 18, 20-25, 27, 32-35, 37-43, 46, 47, 53-55 and 58 under 35 U.S.C. § 103(a) as being unpatentable over the '303 patent in view of WO 01/30266 A1 to Van Tassel et al. (hereinafter "the '266 publication").

With respect to Claims 18, 20-25 and 27, Applicant notes that the Examiner indicated Claim 26 to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, in order to expedite prosecution, Applicant has amended Claim 18 to include the limitations of Claim 26, and has canceled Claims 20-21 and 25-26. Applicant reserves the right to pursue the scope of original, unamended claims at a later date. Accordingly, Applicant submits that Claims 18, 22-24 and 27 are in condition for allowance.

With respect to Claim 32-35 and 37-43 as amended above, Applicant respectfully traverses this rejection and the Examiner's characterization of the cited references. Applicant submits that these claims are entitled to the priority date of parent Application Serial No. 09/435,562, filed November 8, 1999, and thus, the '266 publication does not qualify as prior art under 35 U.S.C. § 102(a). See, e.g., Figure 33 of the parent application and accompanying text. Moreover, Applicant submits that the '303 patent does not teach or suggest the unique combination of features recited by these claims. Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn.

With respect to Claims 46 and 47, these claims are dependent on Claim 44 as discussed above, and recite a unique combination of features not taught or suggested by the '303 patent. Applicant also submits that these claims are entitled to the priority date of parent Application Serial No. 09/435,562, filed November 8, 1999, and thus, the '266 publication does not qualify as prior art under 35 U.S.C. § 102(a). Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn.

With respect to Claims 53-55 and 58, Applicant does not necessarily agree with the Examiner's rejection of these claims, but in order to expedite allowance, Applicant has amended Claim 55 to include the limitations of Claim 56, which the Examiner indicated to be allowable. Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn.

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Claims 19, 34-36, 49, 50 and 51

The Examiner rejected Claims 19, 34-36, 49 and 51 under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over WO 01/30266 A1 to Van Tassel et al. (hereinafter "the '266 publication"). Applicant also rejected Claim 50 under 35 U.S.C. § 103(a) as being unpatentable over the '266 publication.

As discussed above, Claim 18 has been amended to be allowable. Applicant submits that Claim 19, which is dependent on amended Claim 18, recites a unique combination of features not taught or suggested by the cited art.

As discussed above with respect to Claims 32-35 and 37-43, Applicant submits that these claims are entitled to the priority date of parent Application Serial No. 09/435,562, filed November 8, 1999, and thus, the '266 publication does not qualify as prior art under 35 U.S.C. § 102(a). Applicant further submits that Claim 36 is also entitled to this priority date. Accordingly, Applicant respectfully requests that the rejection of Claims 34-36 be withdrawn.

With respect to Claims 49-51, these claims as amended are dependent on Claim 44 as discussed above. Applicant submits that these claims are entitled to the priority date of parent Application Serial No. 09/435,562, filed November 8, 1999, and thus, the '266 publication does not qualify as prior art under 35 U.S.C. § 102(a). Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn.

Allowable Subject Matter

Applicant notes with appreciation the Examiner's indicated allowance of Claims 60-71, and the allowability of Claims 26, 48, 56 and 57. As discussed above, Claim 18 has been amended to incorporate the limitations of Claim 26, and Claim 53 has been amended to incorporate the limitations of Claim 55.

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CONCLUSION


Applicant submits that this application is in condition for allowance, and such action is respectfully requested. The Examiner is invited to contact the attorney of record at the number indicated below if any issues require clarification.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2-17-04

By:   
Sabing H. Lee  
Registration No. 43,745  
Attorney of Record  
Customer No. 20,995  
(949) 760-0404

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